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Douglas B. Macrae

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ROPES & GRAY LLP

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EXAMINER

GRAHAM, PAUL J

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2426

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/823,993 | Applicant(s) MACRAE ET AL. | |
| | Examiner PAUL GRAHAM | Art Unit 2426 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>10/27/8,12/8/8</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/27/08 has been entered.

Information Disclosure Statement

2. The references listed on the Information Disclosure statements filed 12/08/08, 10/27/08 have been considered by examiner (see attached PTO-1449).

Response to Arguments

3. Applicant argues:

Youman does not modify a displayed program listing as the does claim 1.

The Examiner respectfully disagrees. Youman does teach a program listing display modified (as correctly assessed by applicant, Remarks, 10/27/08).

Youman also teaches the regularly scrambled channel listing is displayed as the channel is received without scrambling, in response to determination of same, given that at least, when a user determines his preference list and it includes a premium channel to be tuned and viewed, it is based on determining the channel

Art Unit: 2426

received without scrambling (obviously to be viewed). As noted in the instant disclosure (see instant [29]), if a program signal is scrambled, the system may advise the user of such status, figs. 28 show user being advised of a program signal being scrambled (i.e., a pay-per-view or premium channel, (regularly scrambled) is free for the weekend) and see instant [99] where EPG database is updated indicating that previously scrambled program is now unscrambled, just as the messages of Youman, figs. 28 show). Also, *the channel is received without scrambling* is not supported by the instant specification, as noted below. With respect to the arguments against the Lett and Kostreski references, they are moot arguments given the ground of rejection for the amended claims. The applicants' arguments have been fully considered and are not persuasive. Claims 1-12 stand rejected.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 as amended recites: "...modify the displayed program listings to include a second program listing associated with the second television channel in response to determining that the second television channel is received without scrambling." The instant specification, in particular, that cited in Remarks 10/27/08, does not support the new claim language. In fact, an *EPG database* may be updated but there is no mention of *modification of displayed program listings to include a second program listing associated with a second television channel*; with regard to "in response to determining that the second television channel is received without scrambling", there is no support for this language, in fact, it is not clear that there is a *response* to any determination, and the ONLY element verified is that the channel *is now unscrambled*, this is silent on the state of the *channel at reception*.

Claim 2 as amended recites: "... turning ON the second program listing...". There is no support for the claim as amended in the instant specification. In the instant spec [118-121] it is noted that "the channel may be toggled on and displayed with its program listing" but this is not the same as what is claimed.

Claims 4 and 8 as amended recites: "... television channel is received without scrambling." No where in the instant specification is it noted that it is for detecting *that the second television channel is received without scrambling*. This negative limitation violates 35 USC § 112 vis-à-vis a lack of support.

Claim 6 as amended recites: "... receives data from a service provider indicating the periods during which one of the regularly scrambled television programs will be received without scrambling". Does not enjoy support from the instant specification. In fact, it is counter to what is noted in the instant specification, see [99], where a regularly scrambled channel is now unscrambled. Denoting that it is the channel and there is no mention of the program being received without scrambling (a negative limitation not supported--as noted above for claim 4), and the mention of such recitation begs the question of whether a second invention is being claimed, given that such is noted in the instant specification.

Claim 9 as amended recites: "... first program listings associated with the first television channel that provides regularly unscrambled television programs...". There is no support in the instant specification for this amended claim language, in particular a *first program listing* associated with *the first television channel*.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Art Unit: 2426

6. Claims 1-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Youman et al. (5629733).

As to claim 1, Youman discloses a television schedule system configured with an electronic program guide (EPG) database, the system comprising (see Youman, col. 1, ll. 7-11, col. 7, ll.51-55 for EPG info and col. 8, ll. 18-21 for database and note title of patent):

a receiving location for receiving a first television channel and a second television channel, wherein the first television channel provides regularly unscrambled television programs and the second television channel provides regularly scrambled television programs (see Youman, fig. 1, col. 8, ll. 18-21 for location, fig. 8 for regularly unscrambled channels and fig. 10 for regularly scrambled channels); and

a processor configured to:

display program listings including a first program listing associated with the first television channel (see Youman, col. 7, ll. 40-67, col. 8, ll.18-25; col. 9, ll. 8-17, fig. 1 shows a set-top box that is configured to display program listings (of multiple channels)),

determine that the second television channel is received without scrambling by a user that is a non-subscriber to the second television channel Youman does teach that processor determines a channel is received without scrambling, as noted in the instant disclosure (see instant [29]), if a program signal is scrambled, the system may advise the user of such status, figs. 28 show user being advised of a program signal being scrambled (i.e., a pay-per-view or premium channel, (regularly scrambled) is free for the weekend) and see instant [99] where EPG database is updated indicating that previously scrambled program is now unscrambled, just as the messages of Youman, figs. 28 show, the message "get a free sneak peek of HBO..." is for a user who is a non-subscriber to the television channel), and

modify the displayed program listings to include a second program listing associated with the second television channel in response to determining that the second television channel is

received without scrambling (see Youman, col. 8, ll. 21-24 on updating the listings and fig. 10 and 18 showing premium channel schedules).

As to claim 2, Youman discloses the system of claim 1, wherein modifying the displayed program listing to include the second program listing associated with the second television channel (see Youman col. 8, ll. 21-24), for displaying program listings of the program transmitted on the now unscrambled channel (see Youman, fig. 10 with channels for premium service).

As to claim 4, Youman discloses the system of claim 1, further comprising a detector coupled to the processor for detecting that the second television channel is received without scrambling (see Youman, fig. 28A, where the message "Free HBO Preview Tonight" is displayed; here the system detected a previously scrambled channel is going to be available for viewing therefore a detection mechanism must be coupled to the processor).

As to claim 5, Youman discloses the system of claim 4, wherein the processor is configured to modify the displayed program listings based on the output of the detector (see Youman, col. 8, ll. 21-24 and col. 27, ll. 42-54, the processor is certainly configured to modify the program listings).

As to claim 6, Youman discloses the system of claim 1, wherein the processor receives data from a service provider indicating the periods during which one of the regularly scrambled television channels will be unscrambled (see Youman, fig. 28 and 28A, where the figs. Tell that HBO will become available "tonight" or "this weekend"; therefore, the database received the info from the service provider noting that HBO would be unscrambled for this time period).

As to claim 7, Youman discloses the system of claim 1 further comprising a display for displaying a portion of the program listings in a guide format (see Youman, figs. 6, 8, 18, 19, 20, 25 for example displays).

As to claim 8, Youman discloses the system of claim 7, wherein the display further displays a promotional message in the guide for informing a viewer that the second television channel (one of the regularly scrambled television channels) is unscrambled (see Youman, fig. 28A where “Free HBO tonight” is a promotional message of a regularly scrambled channel, it is noted that the received without scrambling negative limitation is not supported in the instant spec).

As to claim 9, Youman discloses the system of claim 8, wherein the promotional message is visually distinguished from the first program listings associated with the first television channel that provides regularly unscrambled television programs of (see Youman, fig. 28 – where the message is in BIG letters and separated from other info on the display).

As to claim 10, Youman discloses the system of claim 8, wherein the portion of the display including the second program listing is displayed upon user selection of the promotional message (see Youman, fig. 28A where user clicks on the promotional message: “Free HBO Preview Tonight” and figs. 9, 10, and 18 show the listing for scrambled channels).

As to claim 11, Youman discloses the system of claim 1, wherein the processor further adds the second television channel into a list of displayed channels (see Youman, figs. 9, 10, 18 show the listings for regularly scrambled channels, the second television channel).

As to claim 12, Youman discloses the system of claim 1, wherein the processor further transmits an order to subscribe the user to a service provider of the second television channel (see Youman, fig. 26 requesting subscription to a movie or special event or family programming; and fig. 9 to order the HBO channel; fig. 10; fig. 23-24a shows the process of subscribing to a channel to watch a movie).

Conclusion

7. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul J. Graham whose telephone number is 571-270-1705. The examiner can normally be reached on Monday-Friday 8:00a-5:00p EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2426

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

pjg
12/25/08

/Annan Q Shang/
Primary Examiner, Art Unit 2424